

## **REMARKS/ARGUMENTS**

### ***Non-Final Office Action***

In the above-mentioned non-final Office Action, claims 181-186, 188-194, 197-212, 214-234, 236-264 and 269-271 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent 6,380,132 (*Mihara et al.*). In response thereto, no claims have been amended or cancelled, and no new claims have been added. Rather, reconsideration and allowance of the claims in view of the following remarks is in respectfully requested.

### ***Amendments to the Specification***

All of the original claims have been hereinabove added to the specification as new paragraphs at the end of the Summary of the Invention portion. The new paragraphs are merely copies of the original claims with minor formatting changes and thus introduce no new matter.

### ***Obviousness Rejections Were Deficient and/or Incomplete and Thus Must Be Withdrawn***

In rejecting the claims, the Examiner gave no patentable weight to paragraphs in each of the independent claims. He referred to them as: (a) "phrases ... directed to potential uses of said claimed product," (b) "phrases ... directed to language as to what it will do and not what it does," (c) "statements of intended use," (d) "use step," (e) "method of use languages," (f) "use limitations," and (g) "use languages," and then accords them no patentable weight because of what he has deemed them to be. In other words, he has provided no MPEP citation, no case law support or other explanation as to why they should be so deemed and thus accorded no patentable weight. Accordingly, these rejections are deficient and/or incomplete and must be withdrawn, Applicant

respectfully contends. If these rejections are repeated in the next Office Action (which would be a non-final Office Action), specific MPEP citations and other explanations are in order.

***Obviousness Rejections As Stated Confuse the Law and Thus Must Be Withdrawn***

The Examiner in his Section 103 rejections stated: “[i]n other words, the use limitations would fail to distinctly claim the intended structural features of the claimed invention, because it would be indefinite to determine what structural features are included in the intended scope.” (Emphasis added.) He also stated: “the use languages fail to distinctly claim intended structural features.” (Emphasis added.)

Applicant respectfully contends that the Examiner with his use of the words “indefinite” and “distinctly” has confused the indefiniteness provisions of Section 112, first paragraph (“... one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention”), with the obviousness provisions of Section 103 in his Section 103 rejections. Accordingly, the Section 103 rejections are improper and must be withdrawn.

(Further, the claims are definite. For example, claim 181 includes “the multi-layered sheet and the first cut line being constructed and adapted to cause the sheet structure or a portion thereof to split on at least a portion of the first cut line when the sheet structure or a portion thereof is bent on the first cut line upwardly only once or downwardly only once.” One skilled in the art would know whether a sheet has the structural property of splitting when bent upwardly only once or downwardly only once.)

***Examiner's Claim Construction Technique is Improper***

As stated above, the Examiner accorded no patentable weight to any of the following phrases: “being constructed and adapted to cause ... to split ...” (claim 181); “... being selected and

constructed, and the cut lines being configured, such that ... to split ..." (claim 200), and "... being structurally capable of causing ... to split ..." (claims 223 and 242).

No explanation was provided in the Examiner's rejections as to why these claimed features do not structurally limit the claims. For example, if a sheet structure splits when bent that is certainly a structural limitation or feature of that sheet structure, and is to be distinguished from a sheet structure which does not split when bent. Whether the sheet structure splits when bent is dependent on a number of structural features of the sheet structure, as would be understood by those skilled in the art, and as explained in the section below relative to Dr. Ugolick's Declaration. Applicant continues to contend that the claimed features are not "intended use, do-not-affect-the-structure limitations."

***Declaration of Dr. Ugolick Dated 02/15/2007***

Dr. Ugolick in his Declaration analyzed each of the phrases at issue above, and he concluded that each was a structural limitation. He further explained in detail why they were structural limitations because they "depend on many if not all of at least the following structural features, as would be apparent to those skilled in the art: below including one or more of the following: (a) depth of the cut line; (b) width of the cut line; (c) the material of the breakable layer; (d) the properties of the paper layer; (e) the thickness of the breakable layer; (f) if any adhesive is used, the properties of the adhesive; and (g) the depth of the penetration, if any, of the cut line into the breakable layer."

Dr. Ugolick discussed Mihara *et al* in paragraph 11 of his Declaration which is copied below.

11. Mihara *et al.* does not describe a construction which splits, divides or separates into attached first and second layer portions when folded, and specifically when folded or bent upwardly only once or downwardly only once. Cut 2 of Mihara is provided to separate the adhesive label 9 from the release sheet 5. (See Abstract; col. 3, lines 18-21; col. 3, lines 49-54; and col. 5, lines 50-55.) In fact, Mihara *et al.* does not want the release sheet 5 to break or split at the cuts 2 as this would make it more

difficult to initiate removal of the labels from the release sheet by separating an easily graspable portion of the label from the release sheet. That is, users want to be able to easily grasp and peel off a unitary predefined sheet adhesive sheet portion or label without fracturing the release sheet in a Mihara *et al.* type of construction. If a portion of the release sheet were to crack and break off and remain adhered to the label, it would defeat the purpose of the Mihara cuts 2, which is to facilitate removal of the labels from the release sheet.

***Rejections Do Not Follow ¶7.37.09 and ¶7.37 of MPEP 707.07(f)***

As set forth elsewhere in this paper, the basis of the Examiner's rejections are not clear. However, if they are "intended use" type rejections then the Examiner has not followed ¶7.37.09 and ¶7.37 of MPEP 707.07(f) in his rejections. And therefore these rejections are improper and should be withdrawn. These two paragraphs are reproduced below.

**¶ 7.37.09 Unpersuasive Argument: Intended Use**

In response to applicant's argument that [1], a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

**Examiner Note**

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of intended use.
2. This form paragraph must be preceded by form paragraph 7.37.

**¶ 7.37 Arguments Are Not Persuasive**

Applicant's arguments filed [1] have been fully considered but they are not persuasive. [2]

**Examiner Note**

1. The examiner must address all arguments which have not already been responded to in the statement of the rejection.
2. In bracket 2, provide explanation as to non-persuasiveness.

Let us assume for the sake of argument that the claim phrases at issue are not structural limitations but rather are “intended uses.” Then and referring to the quote above, it further is respectfully contended that the prior art (*Mihara et al.*) is not capable of performing the “intended use.” This is set forth in Dr. Ugolick’s Declaration as quoted above.

***Examiner’s Claim Construction Is Contrary to Ex Parte Blancato et al.***

On August 13, 2008 the Board of Patent Appeals and Interferences reversed Examiner Nasser Ahmad’s final rejection in *Ex parte Blancato et al.*, Appeal 2008-2274, 8/13/2008. Quoting from that decision:

The Examiner argues that “[t]he phrase ‘to cause tearing of the carrier web and prevent application of the label sheet from a label applicator onto the articles to be labeled’ has not been given any patentable weight because said phrase is directed to an intended use phrase of the claimed composite label web and is not found to be of positive limitation” (Ans. 4).

The claim limitation in which that claim language appears is not intended use but, rather, is a structural limitation of the carrier web, i.e., it structurally limits the carrier web to one that is “free of any cut that could constitute a tab to cause tearing of the carrier web and prevent application of the label sheet from a label applicator onto the articles to be labeled.” (Emphasis added).

**The present Examiner should not continue to repeat Examiner Ahmad’s faulty logic and claim construction technique in the present application, and thus should not continue to construe the phrases at issue as not being structural limitations. To do so would be contrary to the Board’s clear decision in *Ex parte Blancato et al.***

***Examiner's Claim Construction Technique is Contrary to  
Well-Established Law and Practice***

Set forth in the sections of this paper below are detailed discussions of how the Examiner's claim construction "technique" is contrary to the CCPA/Federal Circuit case law, PTO Board Decisions, the MPEP and the practice of other USPTO Examiners.

***A. Examiner's Technique is Contrary to CCPA/Federal Circuit Case Law***

In *In re Hutchinson*, 154 F.2d 135 (CCPA 1946), the claim language was for a laminated article adapted for use in making a template or the like. That case is not on point herein for the reasons set forth below.

First, it is noted that the *Hutchinson* claim language is in the preamble of the claim, while the claim language at issue in the subject application is in the body of the claim.

Second, the *Hutchinson* claim language states potential uses for and not properties of the claimed material. In contrast, the claim language at issue in the subject application describes properties of the material. Referring to the hypothetical which Applicant's counsel and Applicant's technical representative (Dr. Ugolick) discussed with Examiner Ahmad at an earlier personal interview in another application, the claim language at issue here is not "[a] sheet of business cards adapted for use in business transactions, comprising ..." where according to *Hutchinson* the language "adapted for use in business transactions" would not constitute a limitation in any patentable sense.

Third, a discussion of the state of the law beyond the 1946 CCPA *Hutchinson* decision follows. It will be readily apparent therefrom that the Examiner's claim construction technique is improper.

Again, the claim language at issue in the present application is not in the preamble, but rather in the body of the claim. However, even if it were in the preamble, there is no *per se* rule that it is

not accorded patentable weight. Rather it is “a matter to be determined on the facts of each case in view of the claimed invention as a whole.” *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987).

For example, the preambular phrase “an abrasive article” was held to introduce a material limitation in *Kropa v Robie, et al.*, 187 F.2d 150 (CCPA 1951). See *Loctite Corp. v, Ultra-Seal Ltd, et al.*, 781 F.2d 861, 868 (Fed Cir 1985).

The composition of matter claim at issue in *In re Swinehart, et al.* 439 F.2d 210 (CCPA 1971) included in its body (not in its preamble) the phrase “transparent to infrared rays.” The Examiner and the Board held in rejecting the claim that the claim was improperly functional. In its decision reversing the Board, the Court of Customs and Patent Appeals said:

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that 'functional' language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which may be said to hold that there is some other ground for objecting to a claim on the basis of any language, 'functional' or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. § 112.

*In re Swinehart, et al., supra* at 213.

*In re Venezia*, 530 F.2d 956, 959 (CCPA 1976) in interpreting the claim language “each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables,” said “[r]ather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensional that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to this ‘adapted to be affixed’ and ‘adapted to be positioned’ limitations in the third and fourth paragraphs of the claim.” This case is cited in *MPEP 2173.05(g)* as is the above-discussed *Swinehart* case.

That section of the MPEP reads, in part, as follows:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure of specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) ...

It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidizing developing agent” although functional, was perfectly acceptable because it set definite boundaries of the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitation such as “members adapted to be positioned” and “portions ... being resiliently dilatable whereby said housing may be slidably positioned” served to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

The claims at issue are also not directed to a “new intended use of an old product.” Thus, the holding and the logic of *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997) do not apply. *Schreiber* held that “[t]he recitation of a new intended use of an old product does not make a claim to that old product patentable.” The main claim at issue in *Schreiber* was:

[a] dispensing top for passing only several kernels of a popped popcorn at a time from an open-ended container filled with popped corn, having a generally conical shape and an opening at each end, the opening at the reduced end allows several kernels of popped popcorn to pass through at the same time, and means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform and such as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container.” (Emphasis added)

The Federal Circuit in *Schreiber* affirmed the finding of the Patent Office that an attachment to an oil can as disclosed in a prior art patent could structurally be used to dispense popped popcorn as described in the above claim. The Examiner’s finding to that effect established a *prima facie* case



of anticipation, and the applicant did not meet his burden then of showing that the “prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus.”

Citing *Schreiber* the Federal Circuit in its August 21, 2008 decision in *Leggett & Platt, Incorporated et al. v. Vutek*, 2007-1515 (Fed. Cir. 2008), found that the claim language “effective to impinge sufficient UV light on the ink to substantially cure the ink ...” used functional rather than structural language.

The claim languages at issue here are not directed to and do not concern an intended use of the claimed sheet structure. For example, the claim language at issue herein is not for a “sheet structure for use in business transactions” as mentioned above nor is it a “sheet structure capable of covering a window” or a “sheet structure adapted to be placed on a table.” Rather it concerns and defines structural properties of the elements of the sheet structure. For example, splitting when folded is *not* an intended use of the sheet structure, but rather is a structural property of the sheet structure. That is, if the Examiner is contending that the intended use of the subject sheet structure is “bending” or that the intended use is “splitting, then Applicant respectfully submits that that contention is incorrect. Rather, the claim language at issue is a structural feature or limitation of the claimed structure. This is explained in detail above.

In *Computer Docking Station Corporation v. Dell, Inc., et al.*, 519 F.3d 1366 (Fed. Cir. 2008) it was held that the terms “portable computer” and “portable computer microprocessing system,” as used in the preambles of the asserted claims limited the scope of the claims.

Accordingly, the Examiner’s claim construction technique is improper and all of the claim terms/phrases are positive limitations which are to be accorded patentable weight. If the subject rejections are repeated, Applicant requests that the Examiner identify the cases which are being relied upon and provide an analysis thereof.

***B. Examiner's Technique is Contrary to PTO Board Decisions***

The following are examples of relatively recent opinions of the Board of Patent Appeals and Interferences ("Board") on this point. While each of these opinions is not written for publication and is not binding precedent of the Board, they are instructive as to how the Board interprets claim language very similar to that at issue here. These supplement the *Ex parte Blancato et al.* decision discussed in an above section of this paper.

It can be seen from the below-discussed decisions that the Board does not use the Examiner's "technique," but rather considers all similar claim language as introducing positive limitations.

(1) *Ex parte Beigel, et al.*, Appeal No. 2005-0171, Paper No. 11. The Examiner therein contended that "false-sync sequences" language in the preamble was not a positive limitation. The Board disagreed and said that "[t]he 'false-sync sequence' language is indeed a positive limitation since it establishes conditions and an environment in which the claimed data sequence and preamble identifying functions must operate." The Board further disagreed with the Examiner's contention that this "language can be given no patentable weight since such language appears only in the claim preamble and merely recites the intended use of a structure."

(2) *Ex parte Calhoun, et al.*, Appeal No. 2003-1599, Paper No. 17. Claim language "sized and configured" was held to be a positive structural limitation.

(3) *Ex parte Miller, et al.*, Appeal No. 97-0972, Paper No. 13, pages 6-7, "[t]he various functional limitations in the claims (e.g., that the elongated member is 'adapted to extend between an armrest assembly and a set member' set forth a function which the apparatus must be structurally capable of performing (see, e.g., *In re Venezia*, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims (see, e.g., *Ex parte Bylund*), 217 USPQ 492, 498 (Bd. App.

1981)).” That is, the Board said that such functional statements must be given full weight and may not be disregarded in evaluating the patentability.

(4) *Ex parte Prall*, Appeal No. 2003-1556, Paper No. 24. The phrase “the removable spacer layer...is adapted to be completely removed when isotropically etched” was held to impose a “capability requirement of part of the claimed semiconductor structure.” It was therefore given patentable weight, by the Board.

(5) *Ex parte Brick*, Appeal No. 2000-1794, Paper No. 29. In reversing the examiner's rejections of claims 1-11 and 13, the Board referred to *In re Swinehart*, *supra*, and said on page 5 that there is “nothing intrinsically wrong with the use of this [“adapted to be”] technique in drafting a patent claim.” The Board said that this was contrary to the Examiner's arguments that “the recitation that an element is ‘adapted to’ perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re [Hutchison]*, 69 USPQ 138.”

(6) *Ex parte Belisle, et al.*, Appeal No. 2002-2224, Paper No. 33. Claim language “such that the washer is removable from the shaft without breaking the washer or the shaft” was held to be a positive limitation in a patentable sense.

(7) *Ex parte Machida*, Appeal No. 1998-2826, Paper No. 13. Claim language “an elongated plate member adhesively bonded to a surface of a nail shell with an adhesive agent” was found to not be a statement of intended use. Rather, it was held to be “a positive limitation which cannot be ignored in applying prior art.”

(8) *Ex parte Ligler, et al.*, Appeal No. 1999-1384, Paper No. 15. Claim language that “the membrane may be rinsed and said device may be reused” was found to further limit the claimed device so that it is reusable.

(9) *Ex parte Beckage*, Appeal No. 2003-0242, Paper No. 13. The Examiner, citing *In re Hutchinson*, *supra*, contended that terminology that an element is “adapted to” perform a function is not a positive limitation in any patentable sense. The Board disagreed and reversed the Examiner. Citing *In re Venezia*, *supra*, the Board said that “the scope of the claims can be ascertained with a reasonable degree of precision and particularity.”

(10) *Ex parte McSherry*, Appeal No 2008-0899, 8/29/2008. The Board in allowing apparatus claim 17 gave weight in its patentability determination to a communication mechanism “which allows that user to immediately and directly contact a specialist with expertise specific to their unique workplace issues and who is not one of the workplace resources office personnel in order to establish a communication session during which the specialist provides assistance on a specific workplace issue to that user.” *In re Schreiber*, *supra*, was cited.

Accordingly, the Examiner’s claim construction technique is improper and all of the claim terms and phrases at issue are positive limitations which are to be accorded patentable weight.

**C. Examiner’s Technique is Contrary to MPEP 2111.04**

The Examiner’s claim construction technique is contrary to *MPEP 2111.04*, which is set forth below.

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329,

74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby” clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” *Id.*

As set forth earlier in the present paper, whether such clauses are limitations depends on the specific facts of the case; and the present facts justify treating them as limitations. Also, the Examiner, however, has not provided in the Office Action any discussion of the specific facts or why the specific facts of this case require the clauses to not be limitations.

This MPEP section then relies upon and cites two cases, the below-discussed *Hoffer* and *Minton* cases. Careful examination of these cases shows that *MPEP 2111.04* does not impose any limiting effect on the words/clauses/phrases at issue in the claims in this patent application.

*Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005) says that when “a ‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” That is precisely what the Examiner has done in the present Office Action, that is, he has ignored conditions material to patentability.

The claim at issue in *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373 (Fed. Cir. 2003) was a method claim (“a method for trading securities between individuals”) and the clause at issue was “executing a trade of the security ... whereby the security is traded efficiently between the first individual and the second individual.” No weight was given to the “traded efficiently” phrase because a “whereby clause is not given weight when it simply expresses the intended result of a process step positively recited” (emphasis added) and is a laudatory phrase characterizing the result. Clearly, the *Minton* case does not apply to the facts in the present application.

Accordingly, the Examiner's claim construction technique is improper and all of the claim terms are positive limitations which are to be accorded patentable weight. The Examiner has not provided any analysis of why the specific facts of this case require that the phrases at issue should not be treated as limitations despite the fact that Applicant has provided in Dr. Ugolick's Declaration analysis as to why they should be treated as limitations.

***D. Examiner's Technique is Contrary to Practice by Other USPTO Examiners As Illustrated by Exemplary Issued Patents***

As explained above, the Examiner has taken the position that "being constructed and adapted to cause...", "being selected and constructed, and the ...being configured, such that ... " and "... being structurally capable of causing ..." are not to be accorded any patentable weight. Such an interpretation is contrary not only to the law as explained above but also to the practice by other USPTO Patent Examiners.

The following are examples of recent patents generated in a quick word search by counsel which use the same or similar claim language.

Using the Examiner's logic and claim interpretation technique at least most of the claim portions cited below in these issued patents were not and would not be accorded any patentable weight.

Patent No.	Examiner(s)	Claim Portions
6,607,800	Rena Dye	Claim 1: "...the transfer layer being <i>adapted to be</i> attached to the container during use conditions..."
6,620,500	Daniel Zirker Victor S. Chang	Claim 8: "...said coating is <i>capable of</i> receiving, and having fused thereonto, a layer of xerographic toner material."
6,797,371	Daniel Zirker Victor S. Chang	Claim 24: "...the polymer foam is <i>capable of</i> stretch activated release."

<u>Patent No.</u>	<u>Examiner(s)</u>	<u>Claim Portions</u>
6,803,099	Victor S. Chang	Claim 14: "...wherein the particles are <i>capable of</i> substantially resisting crushing upon being subjected to a load of about 60 lb/ft.sup.2 which is dropped a vertical distance of about 1 foot."
6,835,452	Terrel Morris Victor S. Chang	Claim 1: "...a first adhesive region <i>adapted to</i> attach a top portion of the structure to the substrate..."
6,875,487	Terrel Morris Victor Chang	Claim 1: "...w the adhesion layer is <i>capable of</i> being removed from the support without heat..."
6,916,521	Rena Dye	Claim 1: "...a tape <i>constructed to</i> clean a head of a magnetic recording apparatus as it slides along the head..."  Claim 1: "...a cleaning layer <i>constructed to</i> remove debris from a recording head as it slides along the head..."
6,936,342	Terrel Morris Victor S. Chang	Claim 1: "...an absorption sheet <i>configured to</i> absorb drips..."  Claim 1: "a second side <i>configured to</i> adjoin the food..."
6,962,748	Terrel Morris Victor S. Chang	Claim 1: "...said masking material being <i>capable of</i> adhering to paint and of absorbing paint..."
6,972,142	Rena Dye Camie S. Thompson	Claim 1: "...the gauge is <i>capable of</i> measuring the atmospheric humidity by measuring the degree of curl produced by the humidity in the multiple layers of the bottom edge of the card."
6,984,444	Rena Dye Camie S. Thompson	Claim 1: "...at least one support layer <i>adapted to</i> be disposed proximate the vehicle roof..."
7,005,196	Rena Dye Camie S. Thompson	Claim 1: "...each fusible link being <i>adapted to</i> break and electrically isolate the respective sub-electrode from the other sub-electrodes when subject to an anomalously high current..."
7,138,173	Rena Dye Lawrence Ferguson	Claim 1: "...alternating polymeric layers <i>configured to</i> selectively reflect and transmit visible light..."

Patent No.	Examiner(s)	Claim Portions
7,157,128	Rena Dye Lawrence D. Ferguson	<p>Claim 6: "...the optical information recording medium being <b>configured such that</b> the record data can be recorded and reproduced by irradiation of the laser beam..."</p> <p>Claim 9: "...the optical information recording medium being <b>configured such that</b> the record data can be recorded and reproduced by irradiation of the laser beam to said recording layer from a substrate side..."</p> <p>Claims 9 and 10: "...the substrate is formed to be <b>capable of</b> transmitting the laser beam therethrough..."</p>
7,160,590	Rena Dye Chris Bruenjes	Claim 13: "...in the form of a bag <b>adapted to</b> hold a product article therein."
7,175,903	Rena Dye Lawrence D. Ferguson	Claim 1: "...the film is <b>adapted to</b> heat seal to itself..."
7,270,863	Rena Dye Brett A. Crouse	Claim 5: "...the thick cavity part being <b>configured to</b> pass a resin material injected to the molding die from a gate..."
7,285,234	Rena Dye Lawrence D. Ferguson	Claim 15: "...the further ionizing device (6') are <b>adapted to</b> dissipate electrical charge of the powder particles."
7,297,377	Rena Dye Sow-Fun Hon	Claim 1: "...the liquid crystal display device is <b>configured so that</b> a response time between a lowest brightness level and a highest brightness level is less than 16.7 ms..."
7,300,688	Rena Dye Sow-Fun Hon	Claim 1: "...having regions <b>capable of</b> aligning the liquid crystal material in a first alignment..."
7,311,951	Rena Dye Sow-Fun Hon	Claim 1: "...the first relief structure alignment layer being <b>adapted to</b> provide a substantially planar liquid crystal director alignment..."
7,311,953	Rena Dye Sow-Fun Hon	Claim 3: "...signal line driving circuits <b>capable of</b> supplying picture signals to said signal lines..."
7,332,218	Victor S. Chang	Claim 3: "...coordination sites that are <b>capable of</b> solvating ions..."



Accordingly, all of the features/phrases/clauses/terms at issue herein are positive structural limitations and must be accorded patentable weight in the further examination of this application. When they are accorded patentable weight it is clear that the claims are not anticipated by and patentably distinguish over *Mihara et al.*, at least for reasons set forth in Dr. Ugolick's Declaration.

***Examiner Failed to Respond to Applicant's Arguments in Its Last Response and Therefore the Office Action is Incomplete/Deficient***

The treatment of "capable of" and similar claims terms such as "adapted to" by the Federal Circuit (and its predecessor court), the MPEP, and the Board of Patent Appeals and Interferences was discussed and analyzed at length and in detail by Applicant in the Remarks portion of its Amendment dated March 19, 2008. Such terms define the structure by how the structure reacts under certain conditions; in other words, they are structural limitations and are to be accorded full patentable weight and significance.

The construction and weight were clearly laid out in the above-mentioned Amendment. In the subject Office Action, the Examiner, unfortunately, essentially chose to ignore and not comment upon or reference Applicant's analysis in his last Amendment.

The Examiner should have studied and specifically responded to each of the Applicant's Remarks in the prior Amendment. Referring to ¶ 7.38 of MPEP 707.07(4), even when new ground(s) of rejection are made, "[t]he examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." (Emphasis added.) The Examiner failed to do so in the Office Action at issue and thus the action is incomplete/deficient. This deficiency is especially troublesome since the Patent Office has issued ten Office Actions in this application and has never fully addressed the issue at hand, while Applicant has fully addressed it and repeatedly requested a complete response from the Examiner.

The Examiner has not fully responded to the analysis set forth in Applicant's last Amendment. Accordingly, the present Office Action is deficient and must be withdrawn.

***Policy of Compact Prosecution***

The Examiner rejected claims in copending related application Serial No. 11/134,724 as being unpatentable over U.S. Patent 6,173,649 (*Onishi*). It is assumed that the claims in the present application are patentable over *Onishi* since no (alternative) rejections of the claims over *Onishi* have been made. Claims in the '724 application were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims in this application. Since no corresponding rejection was made in this application over the claims in the '724 application, it is assumed that no such rejection will be made in any further Office Actions, especially since ten (10) rejections have already issued in this application, which has been pending for over seven and a half years. Pursuant to the Policy of Compact Prosecution, any further Office Actions which repeat the rejections herein must be complete and fully address all of Applicant's arguments herein.

***Request that SPE Co-Sign All Future Office Actions***

The present Office Action is the tenth Office Action in the present application. Referring to MPEP § 707.02, "... The supervisory patent examiners are expected to personally check on the pendency of each application which is up for the third or subsequent Office action with a view to finally concluding its prosecution."

Accordingly, Applicant hereby requests that the Examiner obtain the Supervisory Primary Examiner's signature on any subsequent Office Action in this application, particularly in view of *Ex parte Blancato et al*, Appeal 2008-2274, 8/13/2008, discussed above, wherein the Board rejected an application in the present Art Unit on the very grounds at issue here.

*Conclusions*


In view of the above, it is respectfully submitted that the claims were improperly construed. When properly construed the claims patently distinguish over *Mihara et al.* Accordingly the present application is in condition for allowance. Issuance of the Notice of Allowance at an early date is in order and is respectfully solicited.

The Examiner is invited to call the undersigned patent counsel for Applicant to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

With respect to this filing, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 503456. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Date: September 15, 2008

Respectfully submitted,

  
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